

REMARKS

I. Amendments

By this amendment, claims 17, 23, 25, 26 and 30 have been amended and claims 1-16, 24, 31, 35 and 36 have been cancelled.

This amendment adds no new matter to the specification. Support for this amendment is found in the specification and claims as filed.

No change of inventorship is necessitated by this amendment.

II. Discussion of the Previously Imposed Restriction Requirement

A Restriction Requirement was imposed by the Examiner on November 28, 2003. On December 16, 2003 Applicants made an election. Now a new Restriction Requirement has been imposed in the Office Action dated February 20, 2004. There is no mention of the previous Restriction Requirement; whether the present Restriction Requirement is in addition to the first, or whether or not the previous Restriction Requirement is superseded by the present Restriction Requirement. Although Applicants suppose that the Examiner has chosen to nullify the previous restriction and election of claims, Applicants respectfully request that the Examiner clarify this point for the record.

III. Discussion of the Presently Imposed Restriction Requirement

A new Restriction Requirement has been imposed by the Examiner. Applicants hereby confirm their election to prosecution the aspects of the invention in Group II (claims 17-34 and 37). The election is made with traverse, as Applicants are unsure as to the status of the previous Restriction Requirement. The Examiner is requested to refer to Sec. II above.

By this amendment, Applicants have cancelled withdrawn claims 1-16, 35 and 36 without prejudice to the filing of future continuing applications. Therefore, Applicants submit that the claims as presently amended are in conformance with the restriction requirement as just imposed.

IV. Discussion of the Rejection under 35 U.S.C. Sec. 112, First Paragraph

Claims 17, 23 and 29 have been rejected under 35 U.S.C. Sec.112, first paragraph as allegedly non-enabled in the recitation of “prodrugs”. Applicants respectfully traverse the rejection.

Prodrugs are described in the specification at page 86, line 8 – page 87, line 3. Applicants believe this information is sufficient for those skilled in the art to understand the term.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection.

V. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph

Claims 23, 25, 27 and 30 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly indefinite for two reasons. Applicants respectfully traverse the rejection. Each aspect of the rejection will be discussed separately below.

In the first aspect of the rejection, the Examiner has objected to the phrase “optionally having substituents” in claims 23, 25 and 30. By this amendment, claims 23 and 25 have been amended to include the substituents recited in claim 24 and claim 30 has been amended to include the substituents recited in claim 31. Applicants respectfully assert that this aspect of the rejection has been overcome.

Applicants do not understand the basis for the second aspect of the rejection. The case which the Examiner has cited (22 USPQ 2d 1828) refers to a decision which confirmed that one claim may only be one sentence long. As claim 27 contains only one sentence, it complies with the ruling of that case.

As to the Examiner’s other pertinent comments, the Applicants know of no bar to a “multiple page” claim and Applicants do not believe that the species claimed exceed a “reasonable number”. Should the Examiner disagree, Applicants respectfully inquire how many compounds the Examiner believes would constitute a “reasonable number”.

Furthermore Applicants do not know what about the claim is “aggravated”, and also have not done anything with the intent to “avoid fees”.

Should the Examiner wish to impose an additional restriction requirement upon the pending claims, the Examiner is invited to do so. However, as there are already at least two sets of restrictions in this case, at this stage of the prosecution a third one may make the record even more confusing.

The Applicants also wish to point out to the Examiner that all of the species of claim 27 fall under the general structure (1b) of claim 23. On page 37, line 3 – page 39, line 1 of the specification, each specific compound of claim 27 is linked with the relevant example number. Each of the Examples shows the structure of the compound. The Examiner is respectfully invited to consider each of the compounds of claim 27 by reviewing their structures as shown in the Examples. Should the Examiner still wish to maintain this rejection, a detailed explanation as to why “there is no generic concept for the claim” is requested.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection.

VI. Discussion of the Rejection under 35 U.S.C. Sec. 103(a) over Kato *et al.*

Claims 17-34 and 37 have been rejected under 35 U.S.C. Sec. 103(a) as allegedly obvious in view of Kato *et al.* (WO 97/24325). Applicants respectfully traverse the rejection.

By this amendment, claims 24 and 31 have been cancelled.

Applicants do not believe that the aspects of their invention set forth in independent claims 17, 19, 23, 27, 30, 32 or 37 are taught or suggested by the cited reference. In the following paragraphs, the cited reference will be discussed in light of each independent claim. Should the Examiner chose to maintain the rejection, Applicants respectfully request that the Examiner’s remarks address each of the independent claims.

*Independent Claim 17 is Unobvious in view of Kato *et al.**

By this amendment, claim 17 has been amended to delete the option for X⁵ to be C-OH. Applicants do not believe that the aspects of their invention as set forth in claim 17 as amended are rendered obvious by the cited reference.

Independent Claims 19, 27 and 32 are Unobvious in view of Kato et al.

Independent claims 19, 27 and 32 recite specific compounds. The structures of the compounds recited in each claim can be reviewed by considering the following information in the specification:

For claim 19 – see page 34, line 19- page 35, line 9 and the Examples section

For claim 27 - see page 37, line 3 – page 39, line 1 and the Examples section

For claim 32 – see page 40, lines 9-16 and the Examples section

Applicants do not believe that these specific compounds are either or taught or suggested by the cited reference. The Examiner's comments have addressed only claims 17 and 23, and so Applicants respectfully request consideration of the independent claims 19, 27 and 32 which recite specific compounds.

Independent Claim 23 is Unobvious in view of Kato et al.

By this amendment, claim 23 has been amended to delete the option for X^2 to be C-OH. Applicants do not believe that the aspects of their invention as set forth in claim 23 as amended are rendered obvious by the cited reference.

Independent Claim 30 is Unobvious in view of Kato et al.

Independent claim 30 was also not addressed specifically in the Examiner's remarks. Applicants disagree that the compounds set forth in claim 30 are generically embraced by Kato *et al.*, so Applicants do not believe that the aspects of their invention as set forth in claim 30 are rendered obvious by the cited reference. In particular, the chain pendant from Q^5 in formula (1c) is not disclosed in the art.

Independent Claim 37 is Unobvious in view of Kato et al.

Independent claim 37 was also not addressed specifically in the Examiner's remarks. Applicants do not believe that the aspects of their invention as set forth in claim 37 are rendered obvious by the cited reference. In particular, there are no examples of fluoro-substituted phenyl groups in the compounds of the cited art.

Claims 18 and 20-22 depend upon claim 17; claims 25, 26, 28 and 29 depend upon claim 23 and claims 33 and 34 depend upon claim 30. Applicants submit that the more specific dependent claims are also not rendered obvious for the reasons provided above.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 103(a) rejection over Kato *et al.*

VII. Conclusion

Reconsideration of the claims as amended and allowance is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

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